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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,580	02/26/2004	Yvonne Appoldt	032498-022	4373

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EXAMINER

HANDY, DWAYNE K

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

11/14/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

### Office Action Summary

**Application No.**

10/786,580

**Applicant(s)**

APPOLDT ET AL.

**Examiner**

DWAYNE K. HANDY

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 9-21, 23 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Dellacoma et al. (EP 0 651 306). This rejection was applied to claims 1-7, 9-21 and 23-26 in the previous Office Action (mailed 3/31/08). It remains in effect for claims 1-7 and 9-21 and now also applies to new claims 27-29. Please see Response to Arguments below.

***Inventorship***

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 8, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dellacoma et al. (EP 0 651 306) in view of Schmid (WO 02/073142 and USPN 7,206,664). Dellacoma teaches every element of claim 8 except for a computer network and event logging or parameters and data. Schmid teaches a system and method for mixing substances. The system is best shown in Figure 1 and described in column 3. The system includes a mixing device having a processor unit (3) with memory unit (3) in communication with an external data server (30) through a communication module (7). The system operates in response to a selection of mixing programs and other user inputs. The mixing formula programs may be accessed from the local processing and

memory unit or may be called up from the external server. Schmid also teaches the recording of data and using the database to compare results and or update the system (column 3, lines 35-41 and column 5, line 40 - column 6, line 26). It would have been obvious to one of ordinary skill in the art to combine the network from Schmid with the device of Dellacoma. One would add the computer network to store programs and to collect and analyze data as in Schmid.

### ***Response to Arguments***

6. Applicant has amended claims 1, 10, 17, 21 and 22 to recite an electronic pipette. Applicant has then argued that this feature is not taught in the prior art (See pages 10, 12 and 13 of Arguments submitted 7/11/08). This argument is persuasive for the Schmid and Nelson references. The 102 rejections involving these references have been removed.

7. This argument is not persuasive with respect to the Dellacoma reference, however. Applicant has provided a definition of the term "pipette" and then argued that the term "pipette" requires that the device be constructed to draw in fluid by suction and retained by closing the upper end of the pipette – and that the metering means (5) of Dellacoma is not a pipette. The Examiner respectfully disagrees and notes that this argument is beyond the scope of the claim as currently written. The Examiner submits that Applicant has not claimed any specific structural elements for the pipette other than

to recite an “electronic pipette”. The Examiner also notes Applicant’s definition but also notes that dictionary.com also provides the following **additional** definitions of “pipette”.

Pipette –

:a slender graduated tube used in a laboratory for measuring and transferring quantities of liquids from one container to another.

pipette. Dictionary.com. *Dictionary.com Unabridged (v 1.1)*. Random House, Inc.

<http://dictionary.reference.com/browse/pipette> (accessed: November 09, 2008).

:a small glass tube, often with an enlargement or bulb in the middle, and usually graduated -- used for transferring or delivering measured quantities.

pipette. Dictionary.com. *Webster's Revised Unabridged Dictionary*. MICRA, Inc.

<http://dictionary.reference.com/browse/pipette> (accessed: November 09, 2008).

These definitions do not specifically require (“often”) the suction feature. Given the Examiner’s duty to give the claim its broadest interpretation and the lack of any specific structure in the claim drawn to a suction element, the Examiner submits that – at its broadest – a pipette as recited in the current claim may simply be comprised of a narrow tube that is used for transferring or delivering measured quantities. This is what Dellacoma shows in Figure 3. In addition **even if** the Examiner were to agree with Applicant that a “pipette” requires a suction element, as being argued by Applicant in their response, the Examiner submits that the metering means of Dellacoma reference **still** would meet that definition of a “pipette”. Referring to Figure 3, if the tube body (52)

were placed into a liquid and then the pin (54) were raised, then suction would draw fluid into the lower portion of the tube body.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DWAYNE K. HANDY** whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dwayne K Handy/  
Examiner, Art Unit 1797  
November 9, 2008

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797